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Serial No. 09/903,954
Garst, M.

facie obvious over these references. The Examiner cites *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980) in support of this holding. Applicants respectfully traverse the finding of *prima facie* obvious for the following reasons.

The present specification indicates that the addition of an alpha adrenergic agent to a topical ophthalmic prostaglandin preparation, in addition to lowering IOP and providing neuroprotection to the optic nerve and retinal neural cells, is surprisingly found to attenuate the inflammatory response (including hyperemia) which usually accompanies the topical administration of prostaglandins. Thus, the claimed combination has fewer deleterious side effects than the use of a prostaglandin alone.

Moreover, the combination provides greater potential IOP lowering ability than either agent alone. As indicated in the specification, alpha adrenergic agents act to decrease intraocular pressure by decreasing the rate of aqueous humor production within the anterior chamber. Prostaglandins, on the other hand, appear to increase the rate of aqueous humor outflow by the uveoscleral route. See specification, page 3, lines 1-19 and page 4, lines 10-24, respectively. This disclosure, which is not attributed to any cited source, is therefore not an admission that this mechanistic information is part of the prior art. Since each of these two agents decrease intraocular pressure by different mechanisms, the combination of the two agents gives an IOP lowering effect greater than in, for example, doubling the dosage of either agent alone and thus effectively saturating the mechanistic pathway particular to that agent. Since each agent uses a different IOP lowering pathway, each pathway's maximal effectiveness may be maximized, resulting is a greater lowering of IOP than would be the case upon merely increasing dosage of a single agent.

The Examiner has cited *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980) ("*Kerkhoven*") as standing for the proposition that a combination of ingredients having the same character is merely the additive effect of each individual component. However, *Kerkhoven* involved process claims rather than composition claims, as in the present application. The *Kerkhoven* court found that a method of making detergents comprising first mixing 2 different individual slurry streams and then drying the mixed slurry was obvious in view of prior art disclosing a method of making detergents by first drying two individual detergent slurry streams and then mixing the dried detergent. In other words, the result of each process was the same mixture of two different detergents.

The *Kerkhoven* court did state, in dicta, that "[i]t is *prima facie* obvious to combine two

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compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition to be used for the very same purpose." *Kerkhoven*, 205 USPQ at 1072. However, the present composition comprises ingredients useful for different purposes: one decreases aqueous humor production, the other increases aqueous humor inflow. One is prone to causing an inflammatory response when used topically, the other is not.

Moreover, the present composition unexpectedly reduces or eliminates the inflammatory response seen when a prostaglandin is used alone. This could not be anticipated from the teachings of the prior art.

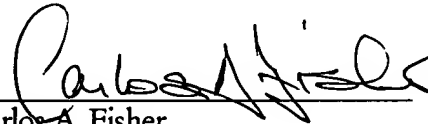
No fee is thought due in connection with the filing of this Reply. However, if Applicant is in error, kindly use our Deposit Account No. 01-0885.

Respectfully submitted,

Dated: _____

11/29/01

By: _____



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